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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,264	01/27/2004	Darryl J.C. Pappin	BP0207-US 2	9574
34313 7590 02/29/2008 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558				
EXAMINER				
GAKH, YELENA G				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
02/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/765,264

**Applicant(s)**

PAPPIN ET AL.

**Examiner**

Yelena G. Gakh, Ph.D.

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-114 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This Office action is in repose to the election of species filed on 01/09/08. It appears that the restriction requirement was misunderstood by the Applicants, and therefore the examiner repeats the requirements in the present Office action. The examiner brings her apology to the Applicants if she was not particularly clear in establishing restriction requirements.

The examiner divided the claims into the groups of species with an intention to have one species elected from each group, rather than the whole group of species elected among other groups. Thus, the group of products of an enzymatic digestion reaction (Group I) comprises several species, one of which should be elected. Also, claim 9 recites another group of species (Group II), one species of which should be elected. The same is true for Group III, from which the species, which are peptides, proteins, or nucleic acids, should be elected, etc.

If the Applicants still have questions regarding election of species, they are respectfully requested to call the examiner.

### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species, with species comprising Groups of species, from each of which one species should be elected:

Group I: the samples are products of an enzymatic digestion reaction (Claims 6 and 52), each sample is a crude or processed cell lysate, a body fluid, a tissue extract or a cell extract (Claim 9) - the list in claim 9 is a separate Group II, each sample is a fraction from a separation process (Claim 10). The species are independent or distinct because the samples are prepared in different ways and therefore have different properties. Currently, Claim 1 is generic.

Group III: analytes are peptides (Claims 14 and 95), proteins (claims 16 and 96) and nucleic acids (Claim 97). The species are different because peptides, whole proteins and DNA require different search. Currently, Claims 1 and 90 are generic.

Group IV: a reactive group is a carboxylic group (Claim 18), an ester group (Claim 20), an ester group from Claim 21 represent Group V; corresponding claims from the set of claims related to the mixture. Molecules with different reactive groups have different structures and therefore require different search. Currently, Claims and 90 are generic.

Group VI: the reporter is a compound from the group listed in Claims 25 and 98 (which is a separate Group VII) or from the group listed in Claims 26 and 99 (which is a separate Group VIII). Molecules with different reporters have different structures and therefore require different search. Currently, Claims 1 and 90 are generic.

Group IX: method, involving reacting sample comprising a reporter moiety which does not substantially sub-fragment (Claims 30 and 101), the linker, which undergoes neutral loss (Claims 31 and 105), bonds X or Y which undergo fragmentation (Claim 32), bond X, which is less prone to fragmentation than bond Y (Claims 33 and 93), bond X is less prone to fragmentation as recited in Claims 34 and 94. The species are independent or distinct because the requirements to the structures and properties of molecules are different, which requires a separate search for the molecules of specific structures. Currently, Claims 5 and 90 are generic.

Group X: the labeled analytes are isomeric labels (Claim 35 and 106), the labeled analytes are isobaric analytes (Claims 36 and 107). Isomeric and isobaric labels are different. Currently, Claims 1 and 90 are generic.

Group XI: isobarically labeled analytes are peptides (Claim 39); the labeled analytes as recited in: Claim 40, Claim 41, Claim 42, Claims 43, Claim 44, Claims 46, and corresponding claims in the group for mixtures. All isobarically labeled analytes have different structures and require different search. Currently, Claims 1 and 90 are generic.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yelena G. Gakh/  
Primary Examiner, Art Unit 1797

02/20/2008